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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101

7590 06/20/2003
Ratner & Prestia
P O Box 980
Valley Forge, PA 19482

EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 06/20/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary

Application No.

09/632,139

Applicant(s)

IMANAKA, RYOICHI

②

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Reissue Applications

35 U.S.C 251

1. Claims 14-22 are rejected under 35 U.S.C. 251 as lacking basis for re-issue. A re-issue application can only be granted for the un-expired portion of the term of the original patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ 2D 1392 (Fed. Cir. 1983).

The patent appears to have been expired due to failure to pay maintenance fees.

Specification

2. The instant application is a division or continuation of other copending reissue applications and the instant application must be amended to include a cross reference to the others at line 1 of the first page of the specification (see 37 CFR 1.177).

For example, the text at page 1, line 1 should be amended to include the following:

--This is a reissue divisional application of serial No. 09/594,152, filed June 12, 2000, which is a reissue of U.S. Patent No. 5,790,172, issued August 4, 1998. Copending application serial Nos. 09/631,542, filed August 3, 2000, 09/632,540, filed August 3, 2000, and 09/817,840, filed March 26, 2001 (now abandoned) are reissue divisional applications of serial No. 09/594,152 --

Surrender of Patent

3. The original patent has been surrendered and filed in co-pending application 09/594,152 on 1/30/2001 (paper #4).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 17 and 18 of copending Application No. 09/594152. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in scope or breadth. For example:

a) the claimed "***A computer information system***" (lines 1-2) of the current application claim 14 corresponds to the "***An information on demand system***" (lines 1-2) of the '152 co-pending application claim 14;

b) the claimed "***a provider for providing information to a recipient***" (lines 3-4) of the current application claim 14 corresponds to the "***a server for providing information responsive to a request from a terminal***" (lines 3-5) of the '152 co-pending application claim 14;

c) the claimed "***said provider charging a different amount to said recipient depending upon whether recording of said information in a medium is effected..***" (lines 6-8) of the current application claim 14 corresponds to the "***charging means for charging a different amount....***" (lines 9-13) of the '152 co-pending application claim 14; and

d) the claimed "***recording of said information...responsive to detection of an identifier***" (lines 9-11) of the current application claim 14 corresponds to the "***wherein when a unique identification (ID) information is detected...the formation provided from said server is recorded into said recording medium.***" (lines 14-18) of the '152 co-pending application claim 14.

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Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in scope or breadth, in that the instant application claim 14 is broader and inclusive in co-pending application claim 14.

The claimed transmission means recited in the instant application claim 15 is obvious because transmitters are necessary technical equipment that are used to provide or deliver audio and video signals over cable, the air or satellite to set top boxes and other television receivers.

The limitations recited in current application claims 16, 19, 20 and 21 correspond to the limitations recited in the '152 co-pending application claims 14 or 17.

The limitations recited in current application method claims 17, 18 and 22 correspond to the limitations recited in the '152 co-pending application method claim 18.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 14-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 16 and 22 of copending Application No. 09/631540. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in scope or breadth. For example:

a) the claimed "***A computer information system***" (lines 1-2) of the current application claim 14 corresponds to the "***An information receiver for at least one of receiving information...***" (lines 1-4) of the '540 co-pending application claim 14;

b) the claimed "***a provider for providing information to a recipient***" (lines 3-4) of the current application claim 14 corresponds to the "***...receiving information....***" (lines 1-2) of the '540 co-pending application claim 14;

c) the claimed "***said provider charging a different amount to said recipient depending upon whether recording of said information in a medium is effected..***" (lines 6-8) of the current application claim 14 corresponds to the "***said information charged differently depending upon whether or not said information is recorded on said recording medium...***" (lines 5-8) of the '540 co-pending application claim 14; and

d) the claimed "***recording of said information...responsive to detection of an identifier***" (lines 9-11) of the current application claim 14 corresponds to the "***said recording medium evaluated***"

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to determine whether said recording medium includes an identifier prior to permitting recording of said information on said recording medium." (lines 9-13) of the '540 co-pending application claim 14.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in scope or breadth, in that the instant application claim 14 is broader and inclusive in co-pending application claim 14.

The claimed transmission means recited in the instant application claim 15 is obvious because transmitters are necessary technical equipment that are used to provide or deliver audio and video signals over cable, the air or satellite to set top boxes and other television receivers.

The limitations recited in current application claims 16, 19, 20 and 21 correspond to the limitations recited in the '540 co-pending application claims 14 or 16.

The limitations recited in current application method claims 17, 18 and 22 correspond to the limitations recited in the '540 co-pending application method claim 22.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Horton et al. (Horton) (4,945,563) (provided by Applicant in the IDS filed 3/11/02- PTO paper #6).

Considering claims 14-20, Horton discloses a computer information system and method for processing information and corresponding recipient system and method comprising:

- a) a provider for providing information to a recipient (receiver 20 figures 1 or 2);
- b) transmission means for transmitting said information to a recipient (a transmission means is in the cable system that transmits the information as described throughout the entire reference including but not limited to at col. 3, lines 30-33);
- c) said provider charging a different amount to said recipient depending upon whether recording of said information in a medium is effected (Three modes are available: view only, view and tape for a fee, view and tape for fee col. 3, lines 43-53); and
- d) recording of said information in said medium is effected responsive to detection of an identifier (i.e. the selected mode indicator received via billing circuit (46) described at col. 3, lines 47-60 or pre-authorization code/indicator indicating one of the modes transmitted on line 48 to VCR 44 as illustrated in figure 2 and described at col. 3, line 61 – col. 4, line 8).

9. Claims 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Russo (5,619,247) (provided by Applicant in the IDS filed 3/11/02- PTO paper #6).

Considering claim 21 and 22, Russo discloses a system and corresponding method for a signal transmitted from a recipient of information to a provider of information (col. 6, lines 21-53), said signal indicating whether said information is recorded in a medium (playback for

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viewing or "play command" indicates that the information was recorded, col. 6, lines 34-45 & col. 10, lines 10-21), wherein said information is charged differently depending upon the signal (i.e. charged differently such as on a bi-weekly basis, directly with a credit clearing house, lump-sum payment, (col. 6, lines 34-45), fee for audio only programs (col. 7, lines 8-12), no charge for preview programs (col. 10, line 63- col. 11, line 4).

Conclusion

10. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

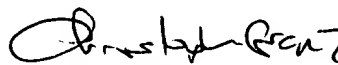
Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755. The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Christopher Grant
Primary Examiner
Art Unit 2611

CG
June 16, 2003